



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,465	01/04/2001	William J. Gray	10655.9900	3628

7590 11/01/2004

Howard I. Sobelman
Snell & Wilmer L.L.P.
One Arizona Center
400 E. Van Buren
Phoenix, AZ 85004-2202

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,465

Applicant(s)

GRAY ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Status of Claims

1. Claims 1, 3-5, 39 and 40 have been examined.

Response to Amendment/Argument

2. The Applicant has amended the claims to include authentication using signature data from a transaction instrument. However, Linehan et al. clearly teach using a digital signature from a transaction instrument to authenticate one of a user and financial account by verifying the signature data from a security server (column 7, lines 20-55).

In response to the 112 rejections applied to claims 4 and 5, the Applicant did not sufficiently address the issues raised by the Examiner. Hence, the rejection is maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 4 and 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 4 is directed to receiving a request at a wallet server that includes receiving a request at a digital wallet. This implies that either the wallet server is, or at least comprises, a digital wallet. This is not supported by the Applicant's Specification (Specification, page 10, lines 20-27).

Claim 5 is directed to a wallet server receiving a request that includes transaction data from a smart card. However, the Specification merely recites a user using a smart card to authenticate a transaction. The smart card of the Applicant's system does not send transaction data (Specification, page 10, lines 1-5 and 10-31; page 11, lines 10-32).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is directed to receiving a request at a wallet server that includes receiving a request at a digital wallet. This implies that either the wallet server is, or at least comprises a wallet (Specification, page 10, lines 20-27), which is not

clear in light of the Applicant's Disclosure. Therefore, for Examination purposes, the Examiner is construing claim 4 to mean receiving a request at a digital wallet and, or along with, receiving a request at the server.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan, U.S. Patent No. 6,327, 578.

As per claims 1-5, 39 and 40, Linehan teaches a method for facilitating a transaction comprising:

- receiving and processing a request at a wallet (column/line 5/61-6/4) server (figure 2, item 214, figure 7; column 8, lines 34-53) to authenticate transaction data (e.g. purchase information, charge information and transaction identifying information) (column 5, lines 55-63; column 6, lines 7-15 and 60-64; wherein said request

includes transaction data (column/line 5/57-6/3; column 7, lines 55-67; column 14, lines 22-40)

- authorizing transaction data by said wallet server (column 6, lines 1-15) to obtain authentication (e.g. authentication token, reference number) from a security server (column 6, lines 20-32)
- associating authentication data with at least one “form” (column 6, lines 20-32) and providing said form to a merchant server to facilitate merchant using said form to obtain authorization from a security server (column 8, lines 4-15)
- using a transaction instrument (e.g. computer, smart card) to transmit the request to the wallet server (figures 2A, C and 3; column 7, lines 20-54)
- receiving a request at a wallet server and at a digital wallet (column/line 2/65-3/3) (e.g. payment request) (column/line 5/50-6/3; column 7, lines 55-62; column 9, lines 35-40; column 14, lines 23-40)

Regarding a coincidence between the security server from which the wallet server receives authentication data and the security server that receives a “form” from a merchant. Linehan teaches a security server such as a bank (figure 2A, items 208 and 212), therefore, if in the Linehan model, the merchant and the user

share the same bank or financial institution, the last limitation of claim 1 is satisfied.

Regarding "forms", in order to settle a dispute a merchant can produce a copy of the token that contains data such as payment amount, order description, time stamp, a random nonce, merchant ID, and customer account reference number. Further, the token is completed, and transmitted to a merchant by the wallet server and the merchant server, in turn, transmits the token to a security server (column 6, lines 20-37). Hence, the token of Linehan satisfies the conditions of a "form" according to Applicant's Disclosure (Specification, page 10, lines 17-28).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,

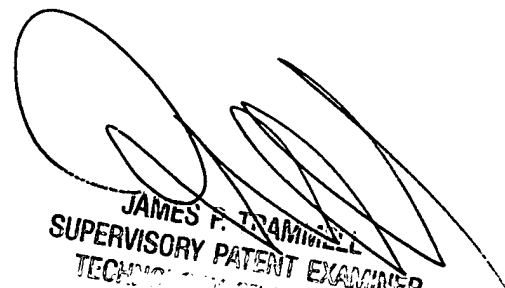
Art Unit: 3621

2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

September 26, 2004



JAMES F. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNICAL CENTER 600